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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/712,864	11/12/2003	Steven M. Hong	9680.241USU1	8639
23552	7590	04/29/2005	EXAMINER	
MERCHANT & GOULD PC P.O. BOX 2903 MINNEAPOLIS, MN 55402-0903			STASHICK, ANTHONY D	
			ART UNIT	PAPER NUMBER
			3728	

DATE MAILED: 04/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Sp

Office Action Summary	Application No. 10/712,864	Applicant(s) HONG ET AL.	
	Examiner Anthony Stashick	Art Unit 3728	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>03082004, 05032004</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 4 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicant uses the phrase “at least one adjustable strap.” in the last two lines of the claim. This phrase renders the claim vague and indefinite because it does not allow one to ascertain the metes and bounds of the claim. The specification does not set forth any amount of strap above that shown in the Drawings. This limitation in the claim would claim an infinite amount of straps, for which applicant has no support in the specification for such a number of straps. Applicant can, however, place this “at least one adjustable strap” language into the description to give applicant the antecedent basis for claiming such a limitation.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-7 are rejected under 35 U.S.C. 102(b) as being anticipated by GB 2,198,923 (GB ‘923). GB ‘923 discloses all the limitations of the claims including the following: a shoe (see Figure 2) comprising a sandal (Figure 1) and a removable bootie (that shown in Figure 2 placed inside the sandal of Figure 1); the sandal being provided with means for securing the sandal about a wearer’s foot 5, 11

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and including an outsole 1; the removable bootie being adapted to cover the wearer's foot and includes a sole (see Figure 2); the removable bootie being provided with means for securing the bootie to the foot (shoelaces shown in Figure 2); the sandal and the bootie being configured to cooperate with each other so that when the bootie is inserted into the sandal and secured therein, the sandal and the bootie combination results in a shoe (see Figure 2); the sandal and bootie can be worn independently (see Figure 1 without bootie); the sandal is open toed (see Figure 2, the toe area is open for at least the "pinky" toe and the "big" toe); the sandal is provided with toe protection means 3; the means for securing the sandal about the foot of the wearer includes at least one adjustable strap (any strap 5 or strap 7); the sandal further includes a heel support portion (portion 7 or the heel portion of the sole); the sandal further includes a heel strap (strap 5 in the heel area or strap 7); the means for securing the bootie about the foot of the wearer includes laces (see Figure 2, laces lace up the bootie)

5. Claims 1 and 3-5 are rejected under 35 U.S.C. 102(b) as being anticipated by WO 94/08478 (WO '478). WO '478 discloses all the limitations of the claims including the following: a shoe (see Figure 10) comprising a sandal (see Figure 10) and a removable bootie 10, 11; the sandal being provided with means for securing 29 the sandal about a wearer's foot and including an outsole 20; the removable bootie being adapted to cover the wearer's foot and includes a sole (see Figure 1, sole is 14); the removable bootie being provided with means for securing the bootie to the foot (the material of the upper of the bootie); the sandal and the bootie being configured to cooperate with each other so that when the bootie is inserted into the sandal and secured therein (see Figure 10), the sandal and the bootie combination results in a shoe (see Figure 10); the sandal and bootie can be worn independently (see Figures 1 and Figure 3); the sandal is provided with toe protection means 25; the means for securing the sandal about the foot of the wearer includes at least one adjustable strap 29; the sandal further includes a heel support portion 27.

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6. Claims 1-6 are rejected under 35 U.S.C. 102(b) as being anticipated by Cunningham 204,483. Cunningham '483 discloses all the limitations of the claims including the following: a shoe (see Figure 1) comprising a sandal A-E and a removable bootie (see Figures 1 and 2); the sandal being provided with means for securing the sandal about a wearer's foot D, E and including an outsole A; the removable bootie being adapted to cover the wearer's foot and includes a sole (see Figure 1); the removable bootie being provided with means for securing the bootie to the foot (buttons shown in Figure 1); the sandal and the bootie being configured to cooperate with each other so that when the bootie is inserted into the sandal and secured therein (see Figure 1); the sandal and the bootie combination results in a shoe (see Figure 1); the sandal and bootie can be worn independently (see Figure 2 without bootie. Any shoe to bootie can be placed within the sandal); the sandal is open toed (between C and D); the sandal is provided with toe protection means C; the means for securing the sandal about the foot of the wearer includes at least one adjustable strap (E, see slit in side of strap in Figure 2); the sandal further includes a heel support portion B; the sandal further includes a heel strap E.

Conclusion

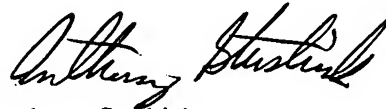
7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure and are cited on form 892 enclosed herewith.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anthony Stashick whose telephone number is 571-272-4561. The examiner can normally be reached on Monday through Thursday from 8:30 am until 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on 571-272-4562. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Anthony Stashick
Primary Examiner
Art Unit 3728

ADS